

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1-57 are pending. Claims 17-33 and 43-56 are withdrawn as being drawn to non-elected subject matter. Compound 2',3'-dihydroxy-4'-methoxy-3,4,5-trifluoro-(Z)-stilbene is the elected species for examination. Claims 4,5,10, 26, 39, 42, 48 and 54 are amended to correct typographical errors. Claims 1-16, 34-42 and 57 remain pending and subject to examination on the merits.

Claim Amendments

Claims 4, 5, 10 and 26 are amended to remove the redundant recitation of sulfonate and sulfonamide in the definition of bridge X. No new matter is added by this amendment

Claims 39, 42, 48 and 54 are amended to correct typographical errors in the term “-CH₂-CH₂=CH₂.” This amendment corrects the failure to subscript numerals and the valency of the central carbon. The correct term, “-CH₂-CH=CH₂” would be readily apparent to one of skill in the art and therefore adds no new matter.

35 U.S.C. § 112, first paragraph (enablement)

Claims 1-16, 34-42 and 57 stand rejected under 35 U.S.C. § 112, as failing to comply with the enablement requirement, “due to the absence of any embodiments or representative examples drawn to any direction as to how to make the compound ZSB-71.” Applicant strongly disagrees with this characterization as the specification provides a generic synthetic scheme and multiple examples of synthesis of closely related compounds at pages 33-64.

As the Examiner notes, many factors, including the breadth of the claims, the nature of the invention, the state of the prior art, the level of ordinary skill in the art, the level of predictability in the art, the amount of direction provided, the existence of working

examples and the quantity of experimentation, must be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement. In the present application, each of these factors supports a conclusion that the claimed invention is fully supported by the specification. The claimed invention is drawn to a very narrow genus of quinone or catechol containing compounds that have the ability to form a reactive oxygen species, more particularly a single compound ZSB-71. The nature of the invention is a chemical compound and compositions including such. The Examiner admits that the state of prior art requires nothing more than routine experimentation. Applicant submits that the level of skill in the art would be sufficient to permit a chemist to perform the standard synthetic procedures, most particularly Wittig reactions, required to synthesize ZSB-71. While the specification does not include an example of synthesis of ZSB-71, the specification does include working examples demonstrating synthesis of more than a dozen closely related compounds utilizing the same types of synthetic procedures that would be used by one to synthesize 2',3'-dihydroxy-4'-methoxy-3,4,5-trifluoro-(Z)-stilbene (ZSB-71). Finally, given the well standard chemical methods used in this synthesis, little to no experimentation would be required to achieve synthesis of the subject compound. Thus every factor supports a conclusion that the present invention is fully enabled by the disclosure.

Applicant reminds the Examiner that "The mere fact that something has not previously been done clearly is not, in itself, a sufficient basis for rejecting all applications purporting to disclose how to do it." 822 F.2d at 1078, 3 USPQ2d at 1304 (quoting *In re Chilowsky*, 229 F.2d 457, 461, 108 USPQ 321, 325 (CCPA 1956)). In fact the MPEP, at section 2164.02 explicitly states that "lack of working examples or lack of evidence that the claimed invention works as described should never be the sole reason for rejecting the claimed invention on the grounds of lack of enablement." However, the lack of an explicit synthesis of ZSB-71 is the sole basis for the present rejection in the present application.

Applicant submits that given the clear description of a general synthetic method applicable to a generate the claimed compounds from appropriate benzaldehydes and phosphorus ylides, one of ordinary skill in the art would have no difficulty following the general synthetic scheme provided at page 33 of the disclosure to make the claimed compounds.. Accordingly, Applicant requests withdrawal of the present rejection.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-4279. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-4279. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-4279.

Respectfully submitted,

By:

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